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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: |) | Examiner: C. Dickerson |
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| MASATO FUKUDA |) | Art Unit: 2625 |
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| Application No.: 10/660,651 |) | Confirmation No.: 7558 |
| | : | |
| Filed: September 12, 2003 |) | |
| | : | |
| For: INFORMATION PROCESSING |) | |
| APPARATUS, A FUNCTION | : | |
| EXTENSION PROGRAM, |) | |
| COMPUTER READABLE STORAGE | : | |
| MEDIUM STORING THE |) | |
| PROGRAM, AND INFORMATION | : | |
| PROCESSING METHOD |) | Date: January 11, 2011 |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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| <p><u>CERTIFICATE OF EFS-WEB TRANSMISSION</u> I hereby certify that this correspondence is being filed electronically by EFS-Web transmission to the United States Patent Office on</p> <p><u>January 11, 2011</u> (Date of Deposit)</p> <p><u>Frank L. Cice</u> (Name of Attorney for Applicant)</p> <p><u>/Frank Cice #42,419/</u> <u>January 11, 2011</u> Signature Date of Signature</p> |
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PRE-APPEAL BRIEF FOR REVIEW

Sir:

Pursuant to the USPTO Official Gazette “New Pre-Appeal Brief Conference Pilot Program”, and in view of the Notice Of Appeal and Pre-Appeal Brief Request For Review Form PTO/SB/33 submitted herewith, Applicant respectfully requests review of the Office Action, and submits the following remarks in support thereof.

Applicant respectfully submits that the instant Office Action is deficient in that it appears to reject the pending claims of the subject application based on inherency, yet fails to provide a rationale or evidence tending to show inherency. Specifically, page 2 of the Office Action, when referencing paragraph [0051] of U.S. Patent Publication No. 2004/0021905 (Holmstead), states that “(i)n the first directory, the image data is deleted or overwritten every thirty days in order to clear that memory space while the second directory maintains that information indefinitely since it is constantly being used. These directory functions are believed to perform the feature of the claim limitation regarding the deletion function since data is being deleted when it is not successively used.” However, Holmstead does not literally state that “data is deleted or overwritten...when it is not successively used”, instead Holmstead states “(f)or example, information stored in directory A **can** be overwritten (and/or erased) every thirty days, because customer A **may** print completely different materials every thirty days. Whereas, customer B **may** send very similar print job elements over an extended period of time, therefore, information stored in directory B **may** be stored indefinitely, so long as there is free memory space available in directory B.” See Holmstead paragraph [0051], emphasis added. That is, Holmstead clearly states that data may or may not be overwritten and/or erased depending on the behavior of a user.

M.P.E.P. § 2112 IV. provides in part that “(t)he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993), emphasis added. According to Holmstead, the data may or may not be overwritten and/or erased as a function of whether or not a user accesses the data. It is therefore indeterminate whether or not the operation of the apparatus disclosed

in Holmstead results in erasure of any data as such an event may or may not happen. Furthermore, “(i)n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464, emphasis added. As clearly stated in Holmstead, data may or not be overwritten and/or erased; therefore, it cannot be said that the feature of deleting image data from a cache memory necessarily flows from the teachings of Holmstead on the basis of fact. Instead, if such a result is to flow at all from Holmstead, the Office Action must provide technical reasoning to reasonably support such a determination. Specifically, the Office Action must provide technical reasoning as how a teaching of data that may or not be overwritten and/or erased inherently discloses deleting from a cache memory image data that is not successively designated as featured in the present claims. No such technical reasoning was provided in the Office Action. Instead, the Office Action states that it is merely “believed” that Holmstead performs deleting image data from a memory cache as featured in the present claims.

As the Office Action apparently makes a rejection of the present claims based on inherency, yet fails to provide either a basis in fact or technical reasoning sufficient to provide a rationale or evidence tending to show inherency, Applicant respectfully submits the Office Action fails to meet its required burden of proof as required by M.P.E.P. § 2112. Accordingly, Applicant submits that there is a clear deficiency in the Office Action and that the Office Action fails to provide a *prima facie* case in support of the rejection.

Applicant submits that in view of the failure of the Office Action to provide a *prima facie* case in support of the rejection, the present Office Action should be vacated, and that a new Office Action should be issued.

CONCLUSION

Applicant's undersigned attorney may be reached in our Costa Mesa, CA office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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